



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION OF

KOCH et al.

Appln. No.: 10/071,233

Filed: February 11, 2002

Title: VIBRATION DAMPER FOR AIRCRAFT ENGINE

Confirmation No.: 9252

Group Art Unit: 3641

Examiner: L. SEMUNENGUS

#15/Elachin
Bentley
9/23/03

August 29, 2003

* * * * *

REPLY TO RESTRICTION REQUIREMENT

Mail Stop Non-Fee Amendment
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
SEP 02 2003
GROUP 3600

Sir:

In reply to the Restriction Requirement dated July 29, 2003, Applicants hereby provisionally elect the invention of Group I, claims 1-16. This election is made with traverse.

The Restriction Requirement on page 2 states that the inventions are distinct because inventions I and II are related as combination and subcombination. MPEP §806.05 identifies that inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. Both requirements must be satisfied in order to establish distinctness.

Applicants respectfully submit that both requirements are not satisfied in this application. Each claim feature set forth in independent claim 1, which is directed to the internal combustion engine, is also found in independent claim 17, which is directed to the aircraft. Accordingly, the combination of Group II requires all of the particulars of the subcombination of Group I. As such, the first requirement of distinctness is not satisfied.

Furthermore, the statements in the Restriction Requirement that “the combination as claimed does not require the particulars of the subcombination as claimed because an aircraft powered by an internal combustion engine without a torsional vibration damper can function equally well with an internal combustion engine with torsional vibration damper” is incorrect. Claim 17, which is directed to the combination, requires a torsional vibration damper like claim 1. This claimed feature cannot be ignored to determine whether or not Group I and II are distinct. It is thus respectfully submitted that the Restriction Requirement is in error and should be withdrawn.

It is also respectfully submitted that the subject matter of the Groups I and II is sufficiently related that a thorough search and examination for any one group would necessarily encompass the search and examination of the remaining group. MPEP §803 states “If the search and examination of entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” In addition, MPEP §803 states that there are two criteria for a proper requirement for restriction between patentable distinct inventions: (A) the inventions must be independent or distinct as claimed; and (B) there must be a serious burden on the examiner if restriction is required. It is respectfully submitted that the search and examination can be made without serious burden and that the criteria for a proper requirement set forth in MPEP §803 has not been met and that the requirement is improper and must be withdrawn.

Finally, it is respectfully submitted that the Restriction Requirement should be withdrawn in order to avoid duplicative examination by the Patent Office and unnecessary expense to Applicants.

Respectfully submitted,

Pillsbury Winthrop LLP

By: 

Glenn T. Barrett

Reg. No.: 38,705

Tel. No.: (703) 905-2011

Fax No.: (703) 905-2500

gbarrett@pillsburywinthrop.com

GTB
1600 Tysons Boulevard
McLean, VA 22102
(703) 905-2000